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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/776,040  
Filing Date: February 01, 2001  
Appellant(s): EHRHARDT ET AL.

\_\_\_\_\_  
Joerg Ehrhardt, et al.  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 5/5/09 appealing from the Office action mailed 12/10/08.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

|           |        |        |
|-----------|--------|--------|
| 5,732,213 | Gessel | 3-1998 |
| 5,027,343 | Chan   | 6-1991 |
| 6,560,723 | Matsui | 5-2003 |

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections – 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5-10, 13, 14, 17, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gessel US Patent 5,732,213 in view of Chan US Patent 5,027,343.

As per claim 1, Gessel teaches a method of setting up a communication procedure between instances comprising the steps of:

Selecting the instances that take part in the communication procedure, one instance being a protocol tester and another instance being an item under test. (see Gessel; column 3, lines 15-32)

Selecting a protocol layer to be emulated by the protocol tester for testing a specified protocol layer of the item under test on the basis of the communication procedure; (see Gessel; column 3, lines 42-58)

Selecting abstract communication interfaces of the emulate protocol layer for the communication procedure; (see Gessel; column 10, lines 20-32)

Selecting communication data contained in description files to be exchanged at the abstract communication interfaces; see Gessel; column 3, lines 15-32; col. 7, lines 50-70)

the abstract communication interface selected from a list of abstract communication interface associated with the select protocol layer (see Gessel; column 3, lines 15-32; col. 7, lines 50-70) and

Automatically setting up through the protocol tester the communication procedure on the basis of the selection made in the above selecting steps, with parameters for the abstract communication interface and the communication data selecting steps being made graphically. (see Gessel; column 6, lines 60-lines 70)

However, Gessel fails to teach the protocol layer selected from a displayed list of protocol layers that are capable of being emulated by the protocol tester, the list of protocol layers including at least one layer 2 protocol from an OSL reference mode;

Chan (5,027,343) teaches the protocol layer selected from a displayed list of protocol layers that are capable of being emulated by the protocol tester, the list of protocol layers including at least one layer 2 protocol from an OSL reference mode; (see Chan, col. 3, lines 1-40, col. 4, lines 20-30)

It would have been obvious to an artisan at the time of the invention to include Chan's teaching with method of Gessel in order to identify and to prevent transmission errors in the setting of circuits and transmission equipment.

As per claim 2, Gessel and Chan teach the method of claim 1. Gessel further teaches the instances selecting step comprises the step of selecting the instances graphically, (see Gessel,

column 11, lines 55-column 12, lines 10) and/or the emulated protocol layer selecting step comprises the step of selecting the emulated protocol layer graphically, and the parameters selectable in these steps being assigned description files that are used in the setting up step. (see Gessel, column 11, lines 55-column 12, lines 10)

As per claim 3, Gessel and Chan teach the method of claim 1. Gessel further teaches the abstract communication interfaces comprise Service Access Points (SAPs). (see Gessel; column 5, lines 35-50)

As per claim 5, Gessel and Chan teach the method of claim 1. Gessel teaches the communication data selecting step comprises the steps of:

Graphically selecting a data format; and

Graphically setting a communication sequence between the selected instances. (see Gessel; column 11, lines 35-80)

As per claim 6, Gessel and Chan teach the method of claim 1. Gessel further teaches the graphically setting up step comprises the step of entering source code. (see Gessel; Column 7, lines 55-70: Script is a source code)

As per claim 7, Gessel and Chan teach the method of claim 6, Gessel further teaches all parameter that may be selected are assigned description files, which are used in step e) for setting up a communication procedure that may be executed between the instance. (see Gessel, col. 7, lines 54-col. 8, lines 19)

As per claims 8-10 they are the means claims of claims 1-3.

As per claim 13, Gessel teaches the method of claim 8. Gessel further teaches all parameters selected by all the selecting means are assigned description files that are used by the setting up means. (see Gessel; Column 7, lines 55-70; Script is a description files)

As per claim 14, it is rejected under the same rationale as claim 3. Supra.

As per claim 17, it is rejected under the same rationale as claim 3. Supra.

As per claim 19, it is rejected under the same rationale as claim 6. Supra.

As per claim 20, it is rejected under the same rationale as claim 1. Supra.

***Claim Rejections – 35 USC § 103***

Claims 4, 11, 15, 16, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gessel US Patent 5,732,213 in view of Chan US Patent 5,027,343 in view of Matsui US Patent 6,560,723.

As per claim 4, Gessel and Chan teach the method of claim 1. However, Gessel fails to teach the communication data comprise at least one type selected from the group consisting of Protocol Data Units (PDUs) and Abstract Service Primitives (ASP)

Matsui teaches the communication data comprise at least one type selected from the group consisting of Protocol Data Units (PDUs) and Abstract Service Primitives (ASP) (see Matsui, column 1, lines 55-column 2, lines 10)

It would have been obvious to an artisan at the time of the invention to include Matsui's teaching with method of Gessel and Chan in order to create a scenario for use in a conformation test.

As per claim 11, which is dependent on claim 8, it is rejected under same rationale as 4.  
Supra.

As per claims 15, 16, and 18, they are rejected under the same rationale as claim 4. Supra.

#### **(10) Response to Argument**

Appellant's argument focused on the following:

A) Whether Gessel teaches additional test parameter –such as a protocol layer, abstract communication interface, service access points, or communication data- may be selected from a displayed list?

A) Gessel teaches this limitation because it displays a list of nodes that service as access points for testing communication protocol layer. (see Gessel, col. 11, lines 35-55) Therefore, Gessel teaches additional test parameter –such as a protocol layer, abstract communication interface, service access points, or communication data- may be selected from a displayed list.

B) Whether Gessel teaches displaying a list of abstract communication interfaces or service access point interfaces that are associated with selected protocol layer?

B) Gessel teaches limitation because it displays a list of the nodes that service as service access points for testing communication protocol layer. (see Gessel, col. 11, lines 35-col. 12, lines 21) Therefore, Gessel teaches displaying a list of abstract communication interfaces or service access point interfaces that are associated with selected protocol layer.

C) Whether it is obvious to combine Gessel and Chan?

C) “Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would



have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007).

In *KSR*, the Supreme Court emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art," *Id.* at 1739, and discussed circumstances in which a patent might be determined to be obvious. *KSR*, 127 S. Ct. at 1739 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966)). The Court reaffirmed principles based on its precedent that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* The operative question in this "functional approach" is thus "whether the improvement is more than the predictable use of prior art elements according to their established functions." *Id.* at 1740.

The Federal Circuit recently recognized that "[a]n obviousness determination is not the result of a rigid formula disassociated from the consideration of the facts of a case. Indeed, the common sense of those skilled in the art demonstrates why some combinations would have been obvious where others would not." *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (citing *KSR*, 127 S. Ct. 1727, 1739 (2007)). The Federal Circuit relied in part on the fact that Leapfrog had presented no evidence that the inclusion of a reader in the combined device was "uniquely challenging or difficult for one of ordinary skill in the art" or "represented an unobvious step over the prior art." *Id.* (citing *KSR*, 127 S. Ct. at 1740-41).

In the present case, the combination of Gessel and Chan is obvious to one of ordinary skill in the art because its provide user with ability to identify and to prevent transmission

errors in the first two layers of circuits and transmission equipments while configuring the network protocol.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Peng Ke

/Peng Ke/

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